

Remarks

In an Office Action dated October 20, 2006, the Examiner restricted the claims of this application to Claim 1 and rejected Claim 1 as anticipated by Cragg. Applicant responded on April 20, 2007, by arguing that Cragg does not anticipate the current invention and amending the claims to more particularly set forth the invention. Subsequently, the Examiner rejected the newly amended claims as non-responsive because the new claims utilized verbiage that was synonymous, but not identical, to elected Claim 1. Applicant respectfully disagrees with Examiner's assertion that the newly presented claims are non-responsive.

The newly presented claims are readable on the elected invention because the newly presented claims are merely more specific and detailed restatements of the elected claim. Applicant believes that the newly presented claims more accurately define the invention and are consistent with the scope of the invention as disclosed. The following explanatory comments regarding the newly presented claims should clarify that the new claims do read on the elected species.

Withdrawn claim 1 calls for "a system for minimal access soft tissue dilating and retracting and nucleus pulposus excision tools for endoscopic spinal surgery, comprising [three elements]." New claim 7 recites "a system for percutaneous endoscopic spinal surgery comprising [3 elements]." The preambles of the two claims are equivalent. The change in wording does not affect the substantive scope of the claim. First, "minimal access" endoscopic spinal surgery and "percutaneous" endoscopic spinal surgery are equivalents. Minimal access refers to a surgery technique of placing a telescope or other surgical tool through a small incision into the surgical

site. Percutaneous refers to a procedure done through a puncture in the skin, typically by a needle or through a very narrow cannula. The words are synonymous for the surgery system described in the specification and claimed here: that of a surgery system performed by utilizing specialized tools to create a small viewing opening through which surgical tools can pass.

The Declaration of Paul M. Tsou, M.D. (the inventor), included in support of this Response, confirms that the systems are the same. Dr. Tsou has specialized in back and spinal surgeries for 35 years, and has acquired an extensive understanding of the terms and phrases used to describe spinal surgeries and techniques. His declaration confirms that a person having ordinary skill in the art of back and spinal surgeries would understand that the phrases "minimal access endoscopic spinal surgery" and "percutaneous endoscopic spinal surgery" refer to the same surgical system.

Furthermore, the equivalents to the phrase "soft tissue dilating and retracting and nucleus pulposus excision tools" in the preamble of claim 1 are covered in the main body of claim 7. In claim 1, detailed explanations of the tools are split between the preamble and the main body of the claim. In contrast, claim 7 places all of the details about the tools in the main body of the claim. Although the verbal structure of the claims is different, the limitations defined by the claims are the same.

For example, "[an element] to seek the appropriate trajectory," in claim 1 is described more specifically in claim 7 as, "[a] first tool having a first circumference...whereby...said first tool is inserted into an incision." Claim 7 further specifies that the first tool is only used to, in

the words of claim 1, "seek the appropriate trajectory," when it explains that the first tool is removed after the second tool has created a viewing opening.

Likewise, the second tool of claim 7 is merely a more specific description of the "dilating and retracting" tool used to "[create] soft tissue tunnel space" described in claim 1. Every phrase relating to the second tool of claim 7 specifies the more general description of the "dilating and retracting" tool of claim 1.

Next, the "nucleus pulposus excision" tool from claim 1 also has an equivalent in claim 7. Claim 7 provides specific details regarding the relative circumference of the surgical excision tool. Claim 7 further specifies the use of the excision tool in the surgical system.

Therefore, because new claim 7 utilizes synonymous language to withdrawn claim 1, the new claim does read on the elected invention. New claims 8 through 12 also read on the elected invention because they are dependent on claim 7.

Finally, new claim 13 reads on the elected invention for the same reason new claim 7 does: both use synonymous language to more specifically describe the elected invention of Claim 1.

Conclusion

In light of the above arguments, it is submitted that this application is in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe that there are matters relating to this application remaining that can be resolved in a telephone interview, the Examiner is urged to call the Applicants' undersigned attorney.

Respectfully submitted,

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